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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,595	11/26/2003	Masatomo Matsubara	325772033300	5975
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102		12/10/2007	EXAMINER RUDOLPH, VINCENT M	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/721,595	Applicant(s) MATSUBARA ET AL.	
	Examiner Vincent M. Rudolph	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-4, 8, 11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tohki ('958).

Regarding claim 1, Tohki ('958) discloses an image forming apparatus (image output apparatus, See Figure 1) that includes a holding portion (image storage means, See Figure 1, Element 100) holding obtained image data (storing the image data that is to be outputted, See Col. 3, Line 54-58), an image-related information producing portion producing image-related information related to the image data (user is able to select different forms of output modes for the image data, See Col. 6, Line 56-62), an accepting portion accepting designation of a destination of the image-related information to be sent (user selects the output mode, such as "Scan to PC", which scans and saves the document as well as

import it to the PC, See Col. 7, Line 1-3), a sending portion sending the image-related information to an external device at the designated destination (the image is imported to the PC from the image output apparatus, See Col. 7, Line 1-3), a receiving portion receiving output form instruction information related to the image data from the external device (the PC instructs to save and print out the file data, See Col. 10, Line 8-13, and transmits the image data to the image output apparatus, See Col. 10, Line 14-17), and an image forming portion forming image data for outputting from the image data held by the holding portion based on the output form instruction information (once the instruct printing is transmitted, the image data is printed out, See Col. 10, Line 15-18).

Regarding claim 3, Tohki ('958) discloses the receiving portion receives as an output form the output form instruction information instructing the print output of the image data (receives an instruction for the printing of the image data, See Col. 10, Line 14-18).

Regarding claim 4, Tohki ('958) discloses the image data is obtained by scanning each document forming a document group (the scanner reads the image data, See Figure 1, Element 6; Col. 4, Line 21-23), the image-related information producing portion produces the image-related information for each document (the user selects the output mode for the designated image data, See Col. 6, Line 56-65), and the receiving portion receives the output form instruction information instructing an output form for each of the documents (user instructs to save the data as well as transmitting the image data to be outputted, See Col. 10, Line 8-18).

Regarding claim 8, Tohki ('958) discloses an image forming method that includes a storing step for storing the obtained image data in a storage device by an image forming apparatus (storing the image data that is to be outputted, See Col. 3, Line 54-58), an image-related information producing step of producing image-related information related to the image data in the image forming apparatus (user is able to select different forms of output modes for the image data, See Col. 6, Line 56-62), a designating step of designating to the image forming apparatus, a destination for the image-related information to be sent (user selects the output mode, such as "Scan to PC", which scans and saves the document as well as import it to the PC, See Col. 7, Line 1-3), an image-related information sending step for sending the image-related information to an image managing apparatus (PC) at the designated destination from the image forming apparatus (the image is imported to the PC from the image output apparatus, See Col. 7, Line 1-3), an image-related information displaying step for displaying in the image managing apparatus, the image-related information received from the image forming apparatus (See Figure 7), an output form instruction producing step of producing in the image managing apparatus, output form instruction information related to the image data (the PC instructs to save and print out the file data, See Col. 10, Line 8-13), an output form instruction information sending step of sending the output form instruction information from the image managing apparatus to the image forming apparatus (transmit the image data from the PC to the image output apparatus, See Col. 10, Line 14-17), and an image forming step of forming the image data for output from the image data stored in the

storage device based on the output form instruction information (once the instruct printing is transmitted, the image data is printed out, See Col. 10, Line 15-18).

Regarding claim 11, Tohki ('958) discloses an image managing apparatus (PC, See Figure 1, Element 24) that includes a receiving portion receiving image-related information related to image data from the image forming apparatus (receives the image data from the image output apparatus, See Col. 7, Line 1-3), a display portion displaying the image-related information (See Figure 7), an output form instruction information producing portion producing output form instruction information instructing an output form of the image data held in the image forming apparatus based on the image-related information (the PC instructs to save and print out the file data, See Col. 10, Line 8-13), and a sending portion sending the output form instruction information to the image forming apparatus (transmits the image data to the image output apparatus, See Col. 10, Line 14-17).

Regarding claim 13, Tohki ('958) discloses that the output form instruction information producing portion produces as an output form, the output form instruction information instructing the print output of the image data (instructs the printing of the image data, See Col. 10, Line 14-18).

Regarding claim 14, Tohki ('958) discloses that the image data is obtained by scanning each of the documents forming a document group (the scanner reads the image data, See Figure 1, Element 6; Col. 4, Line 21-23), the image-related information received from the image forming apparatus includes the image-related information for each of the documents (the user selects the output

mode for the designated image data, See Col. 6, Line 56-65), and the output form instruction information producing portion produces the output form instruction information instructing an output form for each of the documents (user instructs to save the data as well as transmitting the image data to be outputted, See Figure 7; Col. 10, Line 8-18).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 5-7, 9-10, 12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tohki ('958) in view of Suzuki ('927).

Regarding claim 2, Tohki ('958) does not disclose that the image-related information producing portion produces the image-related information that includes an abbreviated image prepared from a part of the image data.

Suzuki ('927) discloses receiving an abbreviated image (reduced resolution image) from a part of the image data onto the display of the PC (See Col. 9, Line 8-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include producing an abbreviated image, such as the one disclosed within Suzuki ('927), and incorporate it into the image

forming apparatus of Tohki ('958) because it allows a user to preview and verify the image data prior to confirming and outputting it using the designated mode.

Regarding claim 5, Tohki ('958) discloses an image forming apparatus (image output apparatus, See Figure 1) that includes a holding portion (image storage means, See Figure 1, Element 100) holding obtained image data (storing the image data that is to be outputted, See Col. 3, Line 54-58), and an accepting portion accepting a setting from an external device (a setting to save the file data or not, See Figure 7).

Tohki ('958) does not disclose that the setting is related to an abbreviated image prepared from the image data, producing the abbreviated image using the image data based on the setting, and sending the abbreviated image to the external device.

Suzuki ('927) discloses selecting the setting for the image data from an external device such that it is related to an abbreviated image (user designates where to output the image data based on the resolution, See Col. 8, Line 45-51), an abbreviated image producing portion producing the image based on the setting (the resolution is set in relation to where the image data is being outputted, See Col. 8, Line 52-Col. 9, Line 7), and using the sending portion for sending the abbreviated image to the external device (sent to the designated outputted location, See Col. 9, Line 8-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include setting an abbreviated image, such as the one disclosed by Suzuki ('927), and incorporate it into the image forming

apparatus of Tohki ('958) because it allows a user to set the resolution for the image data based on the selected outputting location rather than having it automatically chosen, which could further decrease the image quality.

Regarding claim 6, Tohki ('958) does not disclose accepting the setting for designating a resolution of the abbreviated image.

Suzuki ('927) discloses having the user setting the outputting location based on the resolution for outputting the image data (See Col. 8, Line 45-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include setting an abbreviated image, such as the one disclosed by Suzuki ('927), and incorporate it into the image forming apparatus of Tohki ('958) because it allows a user to set the resolution for the image data based on the selected outputting location rather than having it automatically chosen, which could further decrease the image quality.

Regarding claim 7, Tohki ('958) does not disclose that the setting is accepted by the accepting portion from the external device for designating a change of the abbreviated image.

Suzuki ('927) discloses having the user setting a change for the resolution of the image data, such as the outputting location (See Col. 8, Line 45-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include setting an abbreviated image, such as the one disclosed by Suzuki ('927), and incorporate it into the image forming apparatus of Tohki ('958) because it allows a user to set the resolution and

location for the image data rather than having it automatically chosen, which could further decrease the image quality.

Regarding claim 10, Tohki ('958) discloses an image forming method that includes a storing step for storing the obtained image data in a storage device by an image forming apparatus (storing the image data that is to be outputted, See Col. 3, Line 54-58), a first image producing and sending step of producing an image using the image data and sending it to the image managing apparatus (sends the image data to the PC, See Col. 7, Line 1-3), an instructing step of sending an instruction related to the first image from the image managing apparatus to the image forming apparatus (save the selected image data, and print the image data, See Figure 7; Col. 10, Line 8-18), and a second image producing and sending step for producing in the image forming apparatus, a second image to be substituted for the first image using the image data and sending the image (based on the user's instructions, the image data saves over the old data, and stored in the storage device as well as being outputted, as requested, See Col. 10, Line 8-18).

Tohki ('958) does not disclose producing an abbreviated image using the image data and sending it to the image managing apparatus.

Suzuki ('927) discloses producing an abbreviated image using the image data (See Col. 8, Line 52-Col. 9, Line 7) and sending it to the image managing apparatus (See Col. 8-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include producing an abbreviated image, such

as the one disclosed within Suzuki ('927), and incorporate it into the image forming apparatus of Tohki ('958) because it allows a user to preview and verify the image data prior to confirming and outputting it using the designated mode.

Regarding claim 12, Tohki ('958) discloses an accepting portion for accepting an instruction operation using the image and performed by a user for an output form (PC receives the image data, and the user has the option whether to save the data as well as to instruct printing, See Col. 10, Line 8-18).

Tohki ('958) does not disclose having the image-related information include an abbreviated image prepared from the image data and displaying the abbreviated image.

Suzuki ('927) discloses receiving image-related information, such as an abbreviated image (reduced resolution image), from a part of the image data and display it on the PC (See Col. 9, Line 8-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include producing an abbreviated image, such as the one disclosed within Suzuki ('927), and incorporate it into the image forming apparatus of Tohki ('958) because it allows a user to preview and verify the image data prior to confirming and outputting it using the designated mode.

Regarding claim 15, Tohki ('958) discloses an image managing apparatus (PC, See Figure 1, Element 24) that includes a receiving portion receiving image data from the image forming apparatus (receives the image data from the image output apparatus, See Col. 7, Line 1-3), and a sending portion sending instruction information to the image forming apparatus for providing an instruction

related to the image data (transmits the image data to the image output apparatus, See Col. 10, Line 14-17).

Tohki ('958) does not disclose receiving an abbreviated image of the image data from the image forming apparatus.

Suzuki ('927) discloses receiving an abbreviated image (reduced resolution image) from a part of the image data (See Col. 9, Line 8-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include producing an abbreviated image, such as the one disclosed within Suzuki ('927), and incorporate it into the image forming apparatus of Tohki ('958) because it allows a user to preview and verify the image data prior to confirming and sending the data back using the designated mode.

Regarding claim 16, Tohki ('958) does not disclose designating a change of the abbreviated image.

Suzuki ('927) discloses having the user setting a change for the resolution of the image data, such as the outputting location (See Col. 8, Line 45-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include setting an abbreviated image, such as the one disclosed by Suzuki ('927), and incorporate it into the image forming apparatus of Tohki ('958) because it allows a user to set the resolution and location for the image data rather than having it automatically chosen, which could further decrease the image quality.

Regarding claim 17, Tohki ('958) does not disclose an instruction for designating a resolution of the abbreviated image.

Suzuki ('927) discloses having the user set an instruction for the outputting location based on the resolution for outputting the image data (See Col. 8, Line 45-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include setting an abbreviated image, such as the one disclosed by Suzuki ('927), and incorporate it into the image forming apparatus of Tohki ('958) because it allows a user to set the resolution for the image data based on the selected outputting location rather than having it automatically chosen, which could further decrease the image quality.

Regarding claim 9, the rationale provided in the rejection of claim 5 is incorporated herein. In addition, the image forming apparatus of claim 5 corresponds to the image forming method of claim 9 and performs the steps disclosed herein.

Conclusion

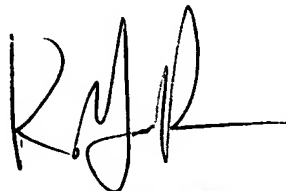
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is: Gann (Pub. # 20050031190) and Quintana (Pub. # 20030231367).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/5/07
VMR



Vincent M. Rudolph
Examiner
Art Unit 2625

KING Y. POON
SUPERVISORY PATENT EXAMINER